

REMARKS

Please cancel Claims 5, 13, 16 and 19 without prejudice. Claims 1-4, 6-12, 14-15, 17-18 and 20-23 are pending. Claims 1-4, 9-10, 15 and 17-18 are amended herein. No new matter is added as a result of the claim amendments. Support for the claim amendments can be found at least on page 6, lines 4-8, of the instant application.

103(a) Rejections

The instant Office Action states that Claims 1-4, 6-12, 14-15, 17-18 and 20-23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Jarwala et al. ("Jarwala," EP 0662616) in view of Applicants' admitted prior art (AAPA). The Applicants have reviewed the cited reference and respectfully submit that the present invention as recited in Claims 1-4, 6-12, 14-15, 17-18 and 20-23 is not anticipated nor rendered obvious by Jarwala, alone or in combination with AAPA.

Claims 1-4, 6-12, 14-15, 17-18 and 20-23

According to independent Claim 1, an embodiment of the present invention is directed to a system that includes "a signal selector ... for selecting between an output signal that is output from said first device and a bypass signal that has bypassed said first device depending on whether said signal selector detects power in a first power rail coupled to said first device" (emphasis added). Claims 2-4 and 6-8 are dependent on Claim 1 and recite additional limitations.

According to independent Claim 9, an embodiment of the present invention is directed to a method that includes "selecting a bypass signal ...; selecting an output signal instead of said bypass signal, ... wherein said output signal is selected when power is detected in a first power rail coupled

to said first device and wherein otherwise said bypass signal is selected” (emphasis added). Claims 10-12 and 14 are dependent on Claim 9 and recite additional limitations.

According to independent Claim 15, an embodiment of the present invention is directed to a system that includes “a first device ... coupled to a first power rail; ... and a signal selector ... also coupled to said first power rail, wherein said signal selector selects from an output signal ... and an input signal ... depending on whether said signal selector detects power in said first power rail” (emphasis added). Claims 17-23 are dependent on Claim 15 and recite additional limitations.

Thus, each and every claim recites that a signal selector selects between one of at least two signals by sensing whether or not power is detected on a power rail.

Applicants respectfully submit that this claimed feature is not shown or suggested by Jarwala. Jarwala explicitly utilizes an externally generated control signal (BCE) supplied from an external source such as a test controller (please refer to column 6, lines 4-25, and in particular lines 17-22, of Jarwala). Indeed, the present claimed invention eliminates such additional control logic (please refer to page 6, lines 4-8, of the instant application).

Applicants further submit that AAPA does not overcome the shortcomings of Jarwala. More specifically, Applicants respectfully submit that AAPA, alone or in combination with Jarwala, does not show or suggest the claim limitations cited above.

Claims 2 and 10

According to the instant Office Action, the limitations of Claims 2 and 10 are inherent in the system of Jarwala. Applicants respectfully disagree. The Examiner is respectfully directed to Section 2112 of the Manual of Patent Examining Procedure (MPEP). The fact that a certain characteristic may be present in the cited reference is not sufficient to establish the inherency of that characteristic. In relying upon inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the alleged inherency of the limitations of Claims 2 and 10; such a basis is not provided in the instant Office Action. As Jarwala fails to even mention a power rail, and as Jarwala explicitly teaches that a control signal is only supplied from an external source, Applicants respectfully submit that there is no basis for concluding that the limitations of Claims 2 and 10 are inherent, and respectfully request that either a basis for reaching the conclusion of inherency, or a reference showing the limitations of those claims, be provided.

Claims 6 and 21

According to the instant Office Action, the limitations of Claims 6 and 21 are inherent in the system of Jarwala. Applicants respectfully disagree. As mentioned above, the fact that a certain characteristic may be present in the cited reference is not sufficient to establish the inherency of that characteristic. Also, in relying upon inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the alleged inherency of the limitations of Claims 6 and 21; such a basis is not provided in the instant Office Action. As Jarwala (alone or in combination with AAPA) fails to even mention a power rail, much less a second power rail, Applicants respectfully submit that there is no basis for concluding that the limitations of Claims 6 and 21 are inherent, and respectfully

request that either a basis for reaching the conclusion of inherency, or a reference showing the limitations of those claims, be provided.

Claims 4, 12 and 18

According to the instant Office Action, Claim 4 is rejected for the same reason as Claim 3, and Claims 12 and 18 are rejected for the same reason as Claim 4. However, Claim 4 as well as Claims 12 and 18 cite limitations different from the limitations of Claim 3. More specifically, Claims 4, 12 and 18 each recite a standby power rail that powers the signal selector and that is in addition to the first power rail recited in the independent claims. As Jarwala fails to even mention a power rail, much less a second or standby power rail, Applicants respectfully submit that Jarwala, alone or in combination with AAPA, fails to show or suggest the limitations of Claims 4, 12 and 18.

Summary

Applicants respectfully submit that Jarwala and AAPA, alone or in combination, do not show or suggest the embodiments of the present claimed invention recited in Claims 1-4, 6-12, 14-15, 17-18 and 20-23, and that these claims are considered patentable over Jarwala and AAPA. Applicants respectfully submit that the basis for rejecting Claims 1-4, 6-12, 14-15, 17-18 and 20-23 under 35 U.S.C. § 103(a) is traversed.

Conclusions

In light of the above remarks, Applicants respectfully request reconsideration of the rejected claims.

Based on the arguments presented above, Applicants respectfully assert that Claims 1-4, 6-12, 14-15, 17-18 and 20-23 overcome the rejections

of record and, therefore, Applicants respectfully solicit allowance of these claims.

Applicants have reviewed the references cited but not relied upon. Applicants did not find these references to show or suggest the present claimed invention: U.S. Patent Nos. 4,675,673 and 5,459,737.

The Examiner is invited to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Date: 1 | 4 | 06

Respectfully submitted,

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